

Attorney Docket No. 5621 P1
Customer No. 49459

REMARKS

A declaration under 37 C.F.R. § 132 is attached to this response.

35 U.S.C. § 103(a) Rejections

Claims 1, 2, and 32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Naphthalimide derivative JP 49-43688 (Noguchi 1), JP 47-12533 (Noguchi 2), GB 1003083 (Kasai), and GB 1054436 (Senhu). The Examiner specifically states the following:

"There is nothing that states that applicants claims have unexpected results. The property of the compounds being fluorescent is expected from the prior art teaching....Regarding applicants statement that the compounds are polymerizable and prior art compounds are not. The examiner argues that there is nothing in the claim to say they are polymerizable. The claims are drawn to monomers. The compounds are similar to the prior art and inherently would also polymerize."

Applicants traverse the Examiner's rejection.

Noguchi 1 teaches a naphthalimide containing composition wherein both benzene rings have a substituent containing a quaternary ammonium group. The compounds are used as fluorescent brightening agents for synthetic fibers. The compositions are not polymerizable.

Noguchi 2 teaches a naphthalimide containing composition wherein both benzene rings have a substituent containing a quaternary ammonium group. The compositions are used for fluorescent whitening of synthetic fibers. The compounds are used as fluorescent brightening agents for synthetic fibers. The compositions are not polymerizable.

Kasai teaches a naphthalimide containing composition wherein the benzene rings do not have a substituent containing a quaternary ammonium group and have only one substituent on one benzene ring. The compounds are for improving the brightness of polymeric materials by treatment of these compounds with the naphthalimide containing composition. The compositions are not polymerizable.

Senhu teaches a naphthalimide containing composition wherein the benzene rings do not have a substituent containing a quaternary ammonium group and have only one substituent on one benzene ring. The compounds are for optical whitening of synthetic organic material by treatment of

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these compounds with the naphthalimide containing composition. The compositions are not polymerizable.

The present invention teaches a composition containing a naphthalimide containing fluorescent moiety. More specifically, there are two benzene groups in the naphthalimide and only one of them has a quaternary ammonium group.

Applicants traverse the Examiner's rejection. None of the references teach the claimed compound. Therefore, the Examiner has argued obviousness. The Applicants infer from the Examiner's rejection that crux of the rejection is based on structural similarity of the compounds and that one of ordinary skill in the art would be motivated to modify the prior art and make the claimed invention. Moreover, Applicants infer from the Examiner's comments that the previous analysis was not persuasive because "the prior art compounds may inherently polymerize" and that the claimed superior property is not convincing because of that fact.

"*A prima facie* case of obviousness based on structural similarity is rebuttable by proof that the claimed compounds possess unexpectedly advantageous or superior properties." MPEP 2144.09 (citing *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963)). Contrary to the Examiner's position, the prior art monomers are not polymerizable by free radical polymerization. Contrary to the prior art, the present invention teaches a composition containing a naphthalimide containing fluorescent moiety that is polymerizable by free radical polymerization and therefore possesses a superior property over the prior art compounds cited by the Examiner – Applicants would like to point out that with respect to this argument, the superior property is that the composition is polymerizable by free radical polymerization. Therefore, Applicants contend that the showing of a superior property of the claimed compound rebuts the rejection of obviousness based on structural similarity.

Applicants would like to address the following Examiner's statement: "Regarding applicants statement that the compounds are polymerizable and prior art compounds are not. The examiner argues that there is nothing in the claim to say they are polymerizable. The claims are drawn to monomers. The compounds are similar to the prior art and inherently would also polymerize."

First, Applicants amend and clarify the claims for the Examiner by adding a limitation into the pending claim – "a fluorescent monomer capable of free radical polymerization."

Second, Applicants submit an additional 37 C.F.R. §132 Declaration to rebut the Examiner's statement that the compounds are similar to the prior art and inherently would also polymerize by free radical polymerization.

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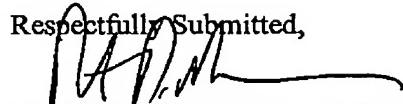
Applicants request that pending claims 1, 2 and 32 are allowed.

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CONCLUSION

Applicants respectfully request that a Notice of Allowance be sent for all pending claims.

Respectfully Submitted,


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